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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,437	05/04/2001	Tim W. Blair	2222.038000H	7818

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EXAMINER

PHAM, KHANH B

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/848,437

Applicant(s)

BLAIR ET AL.

Examiner

Khanh B. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/17/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

AT

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 1, 2005 has been entered. Claims 1-20 have been canceled. Claims 21-90 have been added. Claims 21-90 are pending in this Office Action.

### ***Drawings***

2. The drawings filed May 4, 2001 are informal and only acceptable for examination purpose. New formal drawings are required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims **30-32, 34, 44-46, 48, 58-60, 62, 76, 86-88 and 90** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30-32, 44-46, 58-60, and 86-88 recite the limitation "the at least one object" in line 2. There is insufficient antecedent basis for this limitation in the claims.

Claims 34, 48, 62, 76 and 90 recite the limitation "the initial group of documents" inline 1. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 21-48, 77-90** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**As per claim 21-48**, the language of the claim raise a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101. The process described in claims 21-48 could be applied to a person searching a stack of paper documents and does not require any machine or computer.

**Claims 77-90** recite "a device" but none of the elements of the claimed device necessarily implemented in hardware. The claimed devices comprise only logic and is directed to an arrangement of software, per se, Claims 77-90 are therefore rejected as not being tangible.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 21-90** are rejected under 35 U.S.C. 102(e) as being anticipated by Unger (US 5,721,910 A), hereinafter "Unger".

**As per claim 21**, Unger teaches a method of enabling a user to organize and analyze information comprising:

- "searching an input first group of documents to output a second group of documents" at Col. 3 lines 8-20;

(Unger teaches the step of using predefined search criteria to disaggregate a set of documents into discrete technical categories (i.e., "second group"))

- "analyzing an input third group of documents according to one or more analytical functions to output a fourth group of documents" at Col. 6 lines 25-55.

(Unger teaches the stored analysis may be used to analyze documents and identify a set of documents of particular interest for a particular application)

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- “selectively iterating at least one of the searching of the analyzing using one of the second group or the fourth group as the input” at Col. 3 lines 55-59.

(Unger teaches the step of further searching one or more categories (i.e., “second group”) to identify a subset of documents).

**As per claim 22**, Unger teaches the method of claim 21, further comprising: “making at least one of the second group or the fourth group a permanent group” at Col. 3 lines 45-50.

**As per claim 23**, Unger teaches the method of claim 21, wherein the searching comprises: “performing a cluster analysis of the first group of documents to create a hierarchical arrangement of groups containing documents from the first group, wherein the second group is one of the hierarchical arrangement of groups” at Col. 5 lines 35-63.

**As per claim 24**, Unger teaches the method of claim 21, further comprise “performing a relevancy visualization analysis of one of the first group and the third group to identify how documents contained therein are inter-related with respect to key terms” at Col. 7 lines 5-25.

**As per claim 25**, Unger teaches the method of claim 24, wherein “relevancy visualization analysis operates according to a rule book” at Col. 5 lines 15-35.

**As per claim 26**, Unger teaches the method of claim 25, wherein the rule book comprises patent specific rule” at Col. 5 lines 15-35.

**As per claim 27**, Unger teaches the method of claim 21, further comprising: "generating an object corresponding to a search process component or an analyze process component of a work flow represented by the searching, the analyzing, and selective iterating" at Col. 7 line 25 to Col. 8 line 50.

**As per claim 28**, Unger teaches the method of claim 27, wherein an object is generated using object definition" at Col. 8 lines 35-50.

**As per claim 29**, Unger teaches the method of claim 28, wherein the object definition comprise: "a Boolean operation object definition, a corporate family operating object definition; an export object definition; a folder object definition; an import object definition; a list exploder operation object definition; a list object definition; a query object definition; or a patent family dedupe object definition" at Col. 8 lines 35-50.

**As per claim 30**, teaches the method of claim 27, further comprising: "saving the at least one object" at Col. 7 lines 25-50.

**As per claim 31**, teaches the method of claim 27, further comprising: "re-executing the work flow by traversing the at least one object" at Col. 8 lines 50-62.

**As per claim 32**, Unger teaches the method of claim 27, further comprising: "creating a new work flow by modifying the at least one object" at Col. 8 lines 50-62.

**As per claim 33**, Unger teaches the method of claim 21, further comprising: "annotating at least one of the first group, third group, or any portion of any document contained in the first group or the third group" at Col. 4 lines 50-57.

**As per claim 34**, Unger teaches the method of claim 21, wherein the initial group of documents is from at least one of a database, an external source, or the Internet” at Col. 4 lines 1-2.

**Claims 35-90** recite a method, system, computer program product, and a device for performing similar method as in claims 1-34. Claims 35-90 are therefore rejected by the same reasons discussed above.

### ***Response to Arguments***

8. Applicant's arguments filed August 1, 2005 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

In response to applicants' argument that Unger does not teach or suggest “selectively iterating”, the examiner respectfully submits that Unger teaches the step of using predefined search protocol to identify a set of documents at Col 3 lines 9-15. The identified set of documents is further searched to identify a subset of documents (Col. 3 lines 55-60. This teaching is similar to applicant's method as shown in Fig. 30, where a set of documents 3004 is identified by the search 3002, and the search 3006 is further applied to the set 3004 to identify subset 3008. Unger therefore teaches the step of selectively iterating at least one of the searching using the second group as claimed.

In response to applicant's argument that Unger reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “the output of one stage can be applied as an input to a previously executed



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stage", or "Unger does not teach or suggest a non-linear or multi-directional process"... )are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In light of the foregoing arguments, the 35 U.S.C 102 rejection is hereby sustained.

### ***Conclusion***

9. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (571) 272-3574 for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khanh B. Pham  
Examiner  
Art Unit 2167

September 23, 2005

A handwritten signature in black ink, appearing to read "Khanh B. Pham", with a long horizontal flourish underneath.